

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated November 26, 2008. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-20 are pending in the Application. Claims 13-20 are added by this amendment. By means of the present amendment, claims 1-12 are amended including for better conformance to U.S. practice, such as deleting reference numerals typically used in European practice that are known to not limit the scope of the claims. Further amendments include changing amending dependent claims to begin with "The" as opposed to "A" and correcting certain informalities noted upon review of the claims. By these amendments, claims 1-12 are not amended to address issues of patentability and Applicants respectfully reserve all rights under the Doctrine of Equivalents. Applicants furthermore reserve the right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or continuing applications.

By means of the present amendment, the Abstract is deleted and substituted with the enclosed New Abstract which better conforms to U.S. practice.

By means of the present amendment, the specification is amended to correct a typographic error noted upon review of the specification.

Applicants thank the Examiner for acknowledging the claim for priority and request an indication whether the certified copies of all the priority document(s) have been received from the International Bureau receiving office.

In the Office Action, the Examiner indicates that claims 5 and 10-12 are allowable if rewritten in independent form. Applicants gratefully acknowledge the indication that claims 5 and 10-12 contain allowable subject matter. By means of the present amendment, independent claim 13 is added which includes the features of prior claim 5, however provided in independent form. Further, independent claim 14 is added which includes the features of prior claim 10, however provided in independent form. Claims 15-16 are provided to depend from claim 14 and correspond respectively to prior claims 11-12. Accordingly, consideration and allowance of claims 13-16 is respectfully requested.

In the Office Action, claims 4-6 and 10-12 are rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite due to a lack of structure for providing recited functions. This rejection of the claims is respectfully traversed. It is respectfully submitted that there is nothing improper about a claim element that is claimed functionally.

The MPEP in § 2173.05(g) in addressing Functional Limitations acknowledges that (emphasis added) "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used."

The MPEP further acknowledges that "[a] functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. >In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term 'operatively connected' is 'a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components,' that is, the term 'means the claimed components must be connected in a

way to perform a designated function.' 'In the absence of modifiers, general descriptive terms are typically construed as having their full meaning.' Id. at 1118, 72 USPQ2d at 1006. In the patent claim at issue, 'subject to any clear and unmistakable disavowal of claim scope, the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering.' Id. at 1120, 72 USPQ2d at 1008."

The prior case law has consistently acknowledged that there is nothing wrong with claiming a limitation functionally.

In re Schreider, 128 F3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997) stated that "[a] patent applicant is free to recite features of an apparatus either structurally or functionally ..." It is axiomatic that a functional limitation should be accorded patentable weight. (See, e.g., *Ex parte Sherman*, 45, USPQ 532, 534 (Pat. Off. Bd. App. 1939):

While the claims contain numerous functional statements, these statements seem to be used for the purpose of clearly defining or differentiating elements which have been positively included in the claims. We see no objection to the use to the functional statement to define an element, even where the element may be set forth by the term "means."

The MPEP in § 2173.01 Claim Terminology makes clear that (emphasis added) "Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

There is nothing wrong with describing a claim in functional terms as long as the terms are definite to a person of ordinary skill in the art. The present claims are definite and accordingly, there is nothing wrong with claiming the element functionally.

Accordingly, it is respectfully requested that these rejection of claims 4-6 and 10-12 under 35 U.S.C. §112, second paragraph, be withdrawn.

Claims 1-4 and 6-9 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,492,054 to Sequenot ("Sequenot"). It is respectfully submitted that claims 1-12 and

17-20 are allowable over Sequenot for at least the following reasons.

Sequenot shows an automatic coffee maker that includes a "movable filter plate 5 is seated in the brewing chamber 4' and is engaged by an ejector 6." (See, FIG. 1 and Col. 3, lines 29-31.) Sequenot makes clear that (emphasis added) "the brewing chamber 4' of the extraction cup 4 is filled with a metered amount of powdered beverage and is then guided over the guide path 2 to the position on the left underneath the height-adjustable extraction piston 8, and is moved upward thereafter. In the process, the extraction piston 8 enters the brewing chamber 4' of the extraction cup 4. The powdered coffee in the extraction cup is compressed to a predetermined amount." (See, Col. 3, lines 38-45.) In Sequenot, (emphasis added) "synchronous adjustment of the metering devices 10, 20 and the extraction piston 8, reference is again made to FIGS. 1 and 2. In their totality, the means for adjusting are identified as transmission means 30. They comprise an operating element 31 on the outside of the housing and visible to the user, shown as a turning knob, as well as a toothed belt 34." (See, Col. 5, lines 57-63.) Sequenot makes further clear that (emphasis added) "there is a direct connection between the position of the

operating element 31, the displaceable wall 12 or the displaceable cylindrical front face 24 and the height of the extraction piston 8. The smaller the metered volume, or the smaller the metering chamber 11 or 22, the deeper the extraction piston 8 penetrates into the extraction cup 4." (See, Col. 6, lines 28-34.)

As is clear from Sequenot, the size of the brewing chamber is adjusted through adjustment of the operating element 31 through use of a transmission system.

It is respectfully submitted that the beverage maker of claim 1 is not anticipated or made obvious by the teachings of Sequenot. For example, Sequenot does not disclose or suggest, a beverage maker that amongst other patentable elements, comprises (illustrative emphasis added) "a brewing arrangement bounding a brewing chamber downstream of the water supply structure for receiving water supplied by the water supply structure; said brewing arrangement comprising a bounding member adjustable for adjusting the operational size of the brewing chamber and an adjustment structure for adjusting said bounding member; ... wherein said adjustment structure is configured to adjust in response to the quantity of particles present in said brewing chamber" as recited in claim 1 and as similarly recited in claim

17. In Sequenot, the size of the brewing chamber is directly adjusted through adjustment of the operating element 31 regardless of the quantity of particles present in the brewing chamber, even regardless of whether there is no quantity of particles present in the brewing chamber.

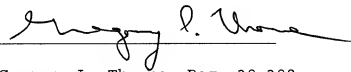
Based on the foregoing, the Applicants respectfully submit that independent claims 1 and 17 are patentable over Sequenot and notice to this effect is earnestly solicited. Claims 1-11, and 18-20 respectively depend from one of claims 1 and 17 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.



Applicant has made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By 

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